

Application No.: 09/662,224

Amendment and Request for RCE dated: September 15, 2005

Reply to Office Action dated: June 28, 2005

### **REMARKS/ARGUMENTS**

Applicants thank the Examiner for the courtesy extended during the personal interview on August 30, 2005.

Claims 94-108 and 169-199 are pending in the application. Claims 1-33 are cancelled. Claims 34-93, and 109-168 are withdrawn. Claims 94-95, 107, 169-170, 174-175, 182, 184-185, 189-190, 197, and 199 have been amended.

Claims 94, 102, 106-107, 169, 177, 181-182, 184, 192, 196-197, and 199 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,320,102 to Paul et al (Hereinafter "Paul"). Claims 96, 171, and 186 are rejected under 35 U.S.C. §103(a) as being unpatentable over Paul in view of U.S. Patent No. 5,291,401 to Robinson et al (Hereinafter "Robinson"). Claims 103-105, 108, 178-180, 183, 193-195, and 198 are rejected under 35 U.S.C. §103(a) as being unpatentable over Paul in view of U.S. Patent No. 5,206,023 to Hunziker et al (Hereinafter "Hunziker"). Claims 95, 97-101, 170, 172-176, 185, and 187-191 are objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent base form.

#### **Rejections under 35 U.S.C. §102**

Claims 94, 102, 106-107, 169, 177, 181-182, 184, 192, 196-197, and 199 are rejected under 35 U.S.C. §102(b) as being anticipated by Paul. Paul discloses diagnosing Proteoglycan deficiency in articular cartilage based on quantified signal intensities of pixels of a magnetic resonance image (MRI) extending across a depth of the articular cartilage (See Abstract).

After discussion with the Examiner on August 30, 2005, Applicants have amended the

Application No.: 09/662,224

Amendment and Request for RCE dated: September 15, 2005

Reply to Office Action dated: June 28, 2005

claims as shown above. At that time, the Examiner agreed that such an amendment would make the claims not anticipated by Paul under 35 U.S.C. §102(b).

**Rejections under 35 U.S.C. §103**

Claim 96, 171, and 186 is rejected under 35 U.S.C. §103(a) as being unpatentable over Paul in view of Robinson. Robinson discloses a teleradiology system for sending the raw data from a complete patient study to a remote location for a radiologist to make a final diagnosis (*See Abstract*).

After discussion with the Examiner on August 30, 2005, Applicants have amended the claims as shown above. While the written summary only references Paul as not anticipating the present claims under 35 U.S.C. §102 (b), the Examiner orally agreed that such an amendment would make the claims patentable over Paul and Robinson.

Claims 103-105, 108, 178-180, 183, 193-195, and 198 are rejected under 35 U.S.C. §103(a) as being unpatentable over Paul in view of Hunziker. Hunziker discloses methods and compositions for the treatment and repair of defects or lesions in the cartilage of humans and other animals (*See Abstract*).

After discussion with the Examiner on August 30, 2005, Applicants have amended the claims as shown above. While the written summary only references Paul as not anticipating the present claims under 35 U.S.C. §102 (b), the Examiner orally agreed that such an amendment would make the claims patentable over Paul and Hunziker.

It is believed that this Amendment places the application in condition for allowance, and early favorable consideration of this Amendment is earnestly solicited.

Application No.: 09/662,224

Amendment and Request for RCE dated: September 15, 2005

Reply to Office Action dated: June 28, 2005

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the telephone number listed below.

The Office is hereby authorized to charge any fees, or credit any overpayments, to Deposit Account No. 11-0600.

Respectfully submitted,

KENYON & KENYON

Dated: September 15, 2005

By: Stephen T. Neal  
Stephen T. Neal  
(Reg. No. 47,815)

KENYON & KENYON  
333 West San Carlos St., Suite 600  
San Jose, CA 95110

Telephone: (408) 975-7500  
Facsimile: (408) 975-7501  
Customer No. 36806